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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/768,154

02/02/2004

Hideki Yamamoto

118535

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EXAMINER

WILLS, MONIQUE M

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

01/22/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/768,154	<b>Applicant(s)</b> YAMAMOTO	
	<b>Examiner</b> Monique M. Wills	<b>Art Unit</b> 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4--14 & 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-14 & 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is responsive to the Amendment filed September 29, 2004. The rejection of claims 1 & 4-15 under 35 U.S.C. 103(a) as being unpatentable over JP 4-105590 in view of Miyazawa et al. JP 09-0263555 is overcome. Claims 1 & 4-14, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 4-105590 in view of Miyazawa et al. JP 09-0263555 and further in view of Frye U.S. Pat. 3,293,078.

### ***Claim Rejections - 35 USC § 103***

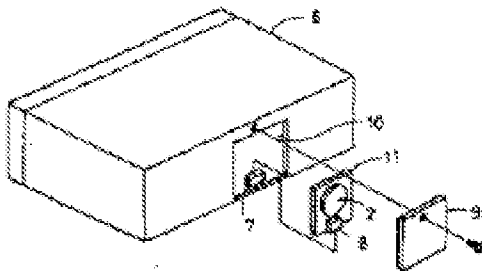
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 4-14, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 4-105590 in view of Miyazawa et al. JP 09-0263555 and further in view of Frye U.S. Pat. 3,293,078.

JP 4-105590 teaches a structure for mounting a backup battery, comprising a storage portion provide in a body of an apparatus and includes a recess, which

opens at the outside of the apparatus and stores the backup battery therein; and a cover which is attached to the body of the apparatus to cover the backup battery put in the recess. A partition wall (10) separates the storage portion from the inside of the apparatus. See Figure 1.



With respect to the intended use limitations of claims 10- 13, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ F.2d 1647 (1987). Therefore, although the limitations have been considered they are not given patentable weight, as they do not differentiate the claimed apparatus from JP 4-105590. While intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. In *re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In *re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). Claims directed to

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apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). See also MPEP § 2114. The manner of operating the device does not differentiate an apparatus claim from the prior art. A claim containing a “ recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

However, JP 4-105590 does not expressly disclose a circuit board built in the apparatus, including a lead wire connection portion to the backup battery. The reference is also silent to the connection power between the circuit board and the lead wire comprising a male-female fitting connection. The reference is silent to the connection portion, insertion hole and a part of the lead wire inside an apparatus on a straight line

Miyazawa et al. teaches a battery holder with a circuit board, wherein a pair of lead wires are connected to the thermals. See Figure 1.

Fry teaches that it is well known in the art to have lead wires extend from casing in a straight line. See Figure 1.

It would have been obvious to one of ordinary skill in the art at the time the instant invention was made to employ the circuit board lead wire connection of

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Miyazawa in the structure of JP 4-105590, in order to mount interconnect components of electrical devices.

With respect to employing the lead wires in a straight line, it would have been obvious to one of ordinary skill in the art at the time the instant invention is made to employ the lead wire straight line arrangement of Frye, in the battery assembly of JP 4-105590 in view of Miyazawa, in order to simplify attachment to external load devices.

With respect to the male-female fitting connections, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to employ male-female fitting parts in order provide a secure connection between attachments.

With respect to employing the connection portion, insertion hole and a part of the lead wire inside an apparatus on a straight line, although Miyazawa teaches that the lead wire follows a winding course, it would have been obvious to employ a straight course, since such a modification would have involved a mere rearrangement of parts. See *In re Japikse*, 86 USPQ 70.

### ***Response to Arguments***

Applicant's arguments with respect to the rejection(s) of claim(s) 1 & 4-15 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made above.

### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Monique Wills whose telephone number is (571) 272-1309. The Examiner can normally be reached on Monday-Friday from 8:30am to 5:00 pm.

If attempts to reach Examiner by telephone are unsuccessful, the Examiner's supervisor, Patrick Ryan, may be reached at 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Monique M Wills/  
Examiner, Art Unit 1795

/PATRICK RYAN/  
Supervisory Patent Examiner, Art Unit 1795

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